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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,079	04/10/2001	Robert Smart	169.2021	7417

5514 7590 09/14/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

SON, LINH L D

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 09/829,079	Applicant(s) SMART ET AL.	
	Examiner Linh Son	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed on May 22nd of 2001 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered. Applicant needs to submit the 1449 form for the Information Disclosure Statement.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Claiming of the "software code for performing the steps" is not statutory.

3. To expedite a complete examination of the instant application the claims rejected under 35 U.S.C 101 (nonstatutory) above are further rejected as set forth below in anticipation of application of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8 rejected under 35 U.S.C. 102(e) as being anticipated by Nendell et al, US Patent No. 6343361B1, hereinafter '361.

3. As per claims 1 and 4, "a method and a system for conducting a secure process between an originating device and a target device, said originating device and said target device being interconnected by a network, said method comprising steps of: " is taught in '361 (Col 7 lines 8-15).

"Means for receiving security key information at said originating device" is taught in '361 (Col 7 lines 30-45, and Col 10 lines 20-40).

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"Means for establishing said process between said originating device and said target device" is taught in '361 (Col 8 lines 23-28).

"Means for suspending said process at a stage prior to completion thereof" is taught in '361 (Col 9 lines 5-25).

" Means for receiving corresponding key information at said target device" is taught in '361 (Col 9 lines 3-7).

"... And means for enabling the suspended process to proceed to completion dependent upon receipt of said corresponding key information" is taught in '361 (Col 9 lines 5-25, and Col 10 lines 20-40).

4. As per claims 2 and 5, "a method according to claim 1, whereby said security key information is one of a physical key and an electronic key" is taught in '361 (Col 9 lines 3-25 and Col 10 lines 20-35) [physical key is the smart card and electronic key is the pass-phrase].

5. As per claim s 3 and 6, "a method according to claim 1, whereby said security key is an electronic public key, and said corresponding key is a physical key being a private key" is taught in '361 (Col 9 lines 3-25, Col 10 lines 20-35, and Col 10 lines 42-53) [Public key is the primary key, which is on the smart card, and the private key is the pass-phrase].

6. As per claims 7 and 8, "A computer readable medium storing a computer program, wherein said computer program comprises software code portions for performing the steps of any one of claims 1 to 3" is taught in '361 (Col 6 lines 35-67).

Conclusion

1. Any inquiry concerning this communication from the examiner should be directed to Linh Son whose telephone number is (703)-305-8914.
2. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kim Y. Vu can be reached at (703)-305-4393. The fax numbers for this group are (703)-872-9306 (official fax). Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-9600.
3. Please notice. Due to the Office moving, the telephone numbers above will only be valid until October 15th of 2004. After that, the follow list of numbers will be valid:

Examiner: (571) 272-3856.

Kim Y. Vu: (571) 272-3859

Receptionist: (571) 272-2100

4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIR.I system. Status information for

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published applications may be obtained from either Private PMR or Public PMR.

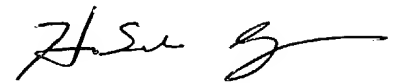
Status information for unpublished applications is available through Private PMR

only. For more information about the PAIR system, see [http://pzr-](http://pzr-direct.uspto.gov)

[direct.uspto.gov](http://pzr-direct.uspto.gov). Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).


AU 2135

Linh LD Son

Patent Examiner